

Applicants: Young-Choon Moon
Application No.: 10/799,507

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REMARKS

The Claim Amendments

Applicant has amended claim 12 to recite "a method of inhibiting GSK-3 activity in an ex vivo biological sample."

Applicant has amended claim 17 according to the Examiner's suggested changes to the antecedent basis. Applicant has also added new claim 23, which depends from claim 17 and corresponds to claim 19; new claim 24, which depends from claim 23; new claim 25, which depends from claim 17 and corresponds to claim 20; and new claim 26, which depends from claim 19 and corresponds to new claim 24. Applicant has amended claim 19 to depend from claim 18. Support for these amendments may be found in the specification and in the claims as originally filed.

Applicant has also amended claim 20 to depend from claim 18 and has amended claim 20 to recite "stroke" instead of "diabetes". Support for this amendment may be found in the specification and in the claims as originally filed (see e.g., page 29, paragraph [0080]).

None of these amendments adds new matter. Their entry is requested.

Applicant reserves the right to pursue canceled subject matter in this application or in future continuing or divisional applications.

The Office Action

37 CFR 1.75(c)

The Examiner has objected to claim 20, which depends from "either of claims 18 or 19" for being improperly multiply dependent. Applicant has amended claim 20 to depend only from claim 18. Applicant has added new claim 25, which corresponds to claim 20 but depends only from claim 17. Applicant has also added new claim 23, which corresponds to claim 19 but only depends from claim 17. Additionally, applicant has amended claim 19 to depend only from claim 18. Finally, applicant has added new claims 24 and 26, which depend from claims 23 and 19, respectively.

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35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 17 and 20 as being indefinite for “failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” The Examiner contends that claim 17 has insufficient antecedent basis, and that claim 20, which is directed towards the use of an “additional therapeutic agent for treating diabetes”, depends from claims specifically drawn towards “a method of treating stroke.” Applicant has amended claim 17 according to the Examiner’s suggestion, and has amended claim 20 to recite “stroke” instead of “diabetes.” thus obviating these rejections.

35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 12 under 35 U.S.C. 112, first paragraph contending that the specification, “while being enabled for a method of inhibiting GSK-3 activity in a standard biological assay, does not reasonably provide enablement for a method of inhibiting GSK-3 activity in a biological sample generally.” Applicant traverses. Nevertheless, to expedite prosecution, applicant has amended claim 12 to recite “a method of inhibiting GSK-3 activity in an ex vivo biological sample.”

Allowable Subject Matter


Applicant acknowledges with appreciation the Examiner’s indication that claims 1-11, 18-19, and 21-22 are allowable.

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CONCLUSION

Applicant requests that the Examiner enter the above amendments, consider the accompanying remarks, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicant requests that the Examiner contact the undersigned at his convenience.

Respectfully submitted,



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